REMARKS

This Response is submitted in reply to the Final Office Action dated February 10, 2005. Claims 1-32 are pending in the patent application. Claims 1-32 were rejected under 35 U.S.C. § 103(a). At least for the reasons set forth below, Applicant believes that the rejections raised in this Final Office Action have been overcome and thus should be withdrawn.

In the Office Action, claims 1-7, 9-14, 16-21 and 23-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,737,481 to Gushima et al. ("Gushima") in view of U.S. Patent No. 4,591,931 to Baumeister ("Baumeister"). Thus, the Patent Office primarily relies on Gushima and further relies on the Baumeister reference to remedy the deficiencies of same. Applicants believe that this rejection is improper and further the combination of Gushima and Baumeister is distinguishable from the claimed invention as defined by claims 1-7, 9-14, 16-21 and 23-28.

Of the pending claims at issue, claims 1, 9, 16 and 23 are independent claims. Independent claim 1 recites a recording apparatus that comprises a recording means for recording a first data set in a recording medium, input means for a user to designate a file name corresponding to a start point and an end point of a desired second continuous data set wherein the second continuous data set is a subset of the first data set to be recorded in or already recorded in the recording medium by the recording means, and control means for controlling the recording means so as to endlessly-record and overwrite a non-designated portion of the first data in the recording medium which excludes the designated second continuous data set such that the recording means endlessly records data in the recording medium in a recording region that avoids the recording region in which the second data has been recorded. Claims 2-7 depend from claim 1 and thus, as a matter of law, incorporate each of the features of claim 1.

Independent claim 9 recites a recording/reproducing apparatus for recording input data in a recording medium capable of non linear access and reproducing and outputting the recorded data that comprises a recording means for recording first data in the recording medium, input means for a user to designate a file name corresponding to a start point and an end point of desired second continuous data wherein the second continuous data is a subset of the first data to be recorded or already recorded in the recording medium by the recording means, control means for controlling the recording means so as to endlessly-record and overwrite a non-designated

portion of the first data in the recording medium excluding the second continuous data such that data is endlessly recorded in a region of the recording medium that avoids the region of the recording medium in which the second continuous data has been recorded, and reproducing means for reproducing and outputting the first data recorded in the recording medium. Claims 10-14 depend from claim 9 and thus, as a matter of law, incorporate each of the features of claim 9.

Independent claim 16 recites a recording method for recording input first data in a recording medium capable of non linear access that comprises endlessly-recording the first data in the recording medium and designating by a user a file name corresponding to a start point and/or end point of desired second continuous data wherein the second continuous data is a subset of the first data to be recorded or already recorded in the recording medium, and endlessly-recording and overwriting a non-designated portion of the first data in the recording medium that excludes the designated second continuous data by recording the data in a region of the recording medium that does not include a recording region in which the second continuous data corresponding to the start point and/or end point out of the first data has been recorded. Claims 17-21 depend from claim 16 and thus, as a matter of law, incorporate each of the features of claim 16.

Independent claim 23 recites a recording/reproducing method for recording input data in a recording medium capable of non linear access and reproducing and outputting the recorded data that comprises the steps of: endlessly-recording input data in the recording medium, and designating by a user a file name corresponding to a start point and/or end point of desired second continuous data wherein the second continuous data is a subset of first data to be recorded or already recorded in the recording medium; endlessly-recording and overwriting a non-designated portion of the first data in the recording medium by recording the data in a region of the recording medium that does not include a continuous second recording region of the recording medium in which second continuous data corresponding to the start point and/or end point out of the first data has been recorded; and reproducing and outputting the first data recorded in the recording medium. Claims 24-28 depend from claim 23 and thus, as a matter of law, incorporate each of the features of claim 23.

As discussed above, each and every independent claim, recites in part, an input means for a user. Thus, this input means allows a user to provide input into the recording process regarding the recorded file. Accordingly, the Patent Office failed to establish a *prima facie* case of obviousness because there is no teaching or suggestion within the cited references that would have led one skilled in the art to make the combination suggested by the Patent Office. Further, one having ordinary skill would not be motivated to combine or modify the cited references because they teach away from each other.

Baumeister is directed towards an apparatus for playing back from recording media recorded information which includes both preselected segments and unpreselected segments. Gushima fails to disclose or suggest such a device. Indeed, Gushima teaches away from any type device that allows input from a user that would allow the user to designate a file name corresponding to a start point and an end point of a desired data point that would allow the user to easily identify the file during playback as suggested by the Patent Office. See, Office Action, pg. 3 through pg. 4. For example, Gushima at least fails to disclose or suggest an input means for a user. In fact, nowhere in Gushima is it even suggested that there is an input means for a user. Additionally, Gushima discloses a recording apparatus wherein the memory controller automatically marks an address location to protect data from being overwritten upon the occurrence of a recording-disable state caused by, for example, an external shock applied to the apparatus. See, Gushima, col. 31, ln. 37-65. Accordingly, Gushima, teaches that the recording method and apparatus function automatically without user input. Thus, Gushima not only fails to disclose or suggest an input for a user, Gushima teaches away from having an input means for a user.

Accordingly, one having ordinary skill in the art would not modify Gushima to have an input means for a user to allow a user to designate a file name corresponding to a start point and an end point of a designated data set, as allegedly taught by Baumeister, when Gushima's disclosure is directed to a fully automatic process.

In addition, the point of Gushima is to continuously and automatically record information. Thus, in contrast to the claimed invention, Gushima does not envision having an input means for a user to designate a file name corresponding to a start point and an end point of

a desired data set. As a result, Gushima does not suggest this claimed element to the extent that it effectively teaches away from same.

Clearly, what the Patent Office has done is to rely on hindsight reasoning to justify the combination and/or motivation of Gushima and Baumeister. Therefore, even if combinable, Gushima and Baumeister fail to disclose or suggest the claimed invention and thus fail to render the claimed invention obvious based upon at least these reasons.

Accordingly, Applicants respectfully request that the obviousness rejection with respect to claims 1-7, 9-14, 16-21 and 23-28 be withdraw.

Claims 8, 15, 22 and 29-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gushima in view of Baumeister and U.S. Patent No. 5,940,241 to Sasakura ("Sasakura") and in further in view of U.S. Patent No. 5,949,953 to Shirakawa et al. ("Shirakawa"). Applicants respectfully submit that the patentability of claims 1, 9, 16 and 23 renders moot the obviousness rejection of claims 8, 15, 22 and 29-32. At a minimum, the cited art fails to teach or suggest the features of claims 8, 15, 22 and 29-32 in combination with the features of claims 1, 9, 16 or 23 based on at least the above reasons discussed above where Sasakura and Shirakawa cannot be relied on solely to remedy the deficiencies of same.

Accordingly, the obviousness rejection should be withdrawn.

For the foregoing reasons, Applicants respectfully submit that the present applicant is in condition for allowance and earnestly solicit reconsideration of the same.

Respectfully submitted,

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